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SHLESINGER, ARKWRIGHT & GARVEY LLP
3000 South Eads Street
Arlington, VA 22202

EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/977,331
Filing Date: October 16, 2001
Appellant(s): PATTERSON, OWEN M.

Michael Zadrozny
For Appellant

EXAMINER'S ANSWER

MAILED
FEB 09 2004
GROUP 3700

This is in response to the appeal brief filed 10/20/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. Additionally the rejection of claims 4, 5, and 21 has been withdrawn. Claims 4, 5, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because there is no separate argument for each of claims 4,

5, 10-16, 18, 19, 21, and 22 as to why they are individually patentable. As noted above the rejection of claims 4, 5, and 21 has been withdrawn.

The rejection of claims 10-16, 18, 19, and 22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

D444,529

Wagner

7-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 6, 7, and 17 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 7.

Claims 10-16, 18, 19, 21, and 22 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7.

(11) Response to Argument

Appellant's first argument is that Wagner is not "enabling" for anticipation.

In response to appellant's argument that Wagner is not anticipatory because it is intended to be used for a different purpose. and thus is not enabled for appellant's purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Appellant's arguments as to what is required for anticipation are not persuasive. Wagner's disclosure is enabling as required under 35 U.S.C. 112, first paragraph. The case law cited by appellant would appear to be relevant if the disclosure were not enabling under this section, and therefore it wasn't clear if it represented anticipatory art. Appellant has not disputed that Wagner provides an enabling disclosure under 35 U.S.C. 112, first paragraph for its intended use and thus as per *Casey* above, Wagner provides all that is required for anticipation. Appellant's assertion that *Casey* is off point is erroneous. Appellant's "enabling" arguments are simply utility arguments as per *Casey* under a different heading and thus *Casey* must control the instant set of facts.

Regarding the orientation of Wagner's device during its intended use, it should be noted that the Wagner device is not disclosed as part of a set on an axle but in and of itself as a separate element so no modification of the disclosed device is required. The examiner's rejection is not based on a set of Wagner type devices attached to an axle, but rather what Wagner in and of itself discloses.

Finally, it is the examiner's position that *Schreiber* merely supports *Casey* with regard to the proposition that if the prior art structure is capable of performing the intended use, then it meets the claim. Wagner's device is clearly capable of performing as a target for a golf ball.

Regarding the claim 1 and 2 argument, Wagner's central portion in cross section forms a truncated cone with a flat surface as labeled by the examiner in Wagner's Fig. 6 (attached).

Concerning the claim 7 argument, Wagner's bore extends from the top to the bottom portion and at either entrance to the bore a shoulder is formed where the bore ends as labeled by the examiner in Wagner's Fig. 6 (attached).

With regard to claim 17, as can be seen in Fig. 2 of Wagner, and labeled by the examiner (attached) the top and bottom portions are mirror images. That these top and bottom portions have other elements added to them for connection to other discs does not affect the mirroring of the top and bottom portions themselves which is all that is claimed.

The only argument over the claim rejections specifically presented by appellant regarding the obviousness type rejection concerns claim 4 which has now been indicated allowable. Thus, this argument is mute.

Regarding the more general arguments raised by appellant, the exact dimensions of Wagner's device would obviously have been dependent on the durability desired and the number of golf balls one wished to be able to collect in a single pass. As can be seen in Wagner's drawings the angle of Wagner's cone and the specific dimensions of the device based on how a golf ball would be picked up appear to be in the range claimed by appellant. Regarding claim 22, the appellant has claimed no particular dimension to the golf hole and such are provided in various sizes. Again

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absent some unexpected results the claimed dimensions would not have been unobvious to the ordinarily skilled artisan manufacturing Wagner's device.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham
Primary Examiner
Art Unit 3711

MSG

February 5, 2004

Conferees:

Greg Vidovich

Tom Hughes

SHLESINGER, ARKWRIGHT & GARVEY LLP
3000 South Eads Street
Arlington, VA 22202



Mark S. Graham
Primary Examiner

FIG. 1

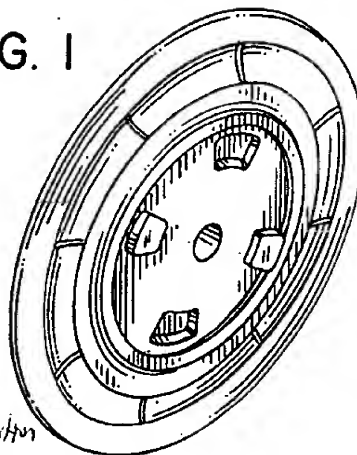


FIG. 2

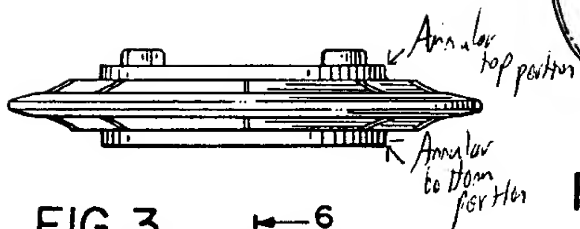


FIG. 3

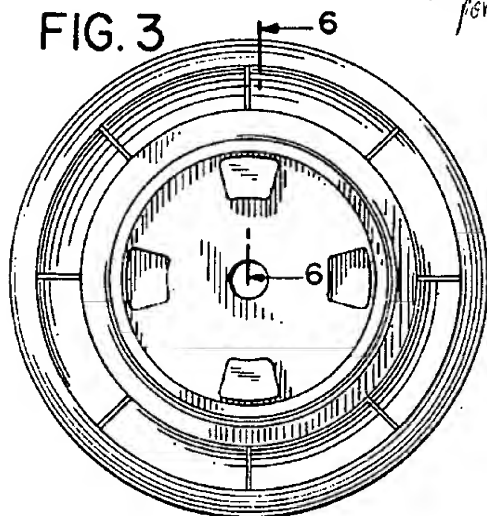


FIG. 4

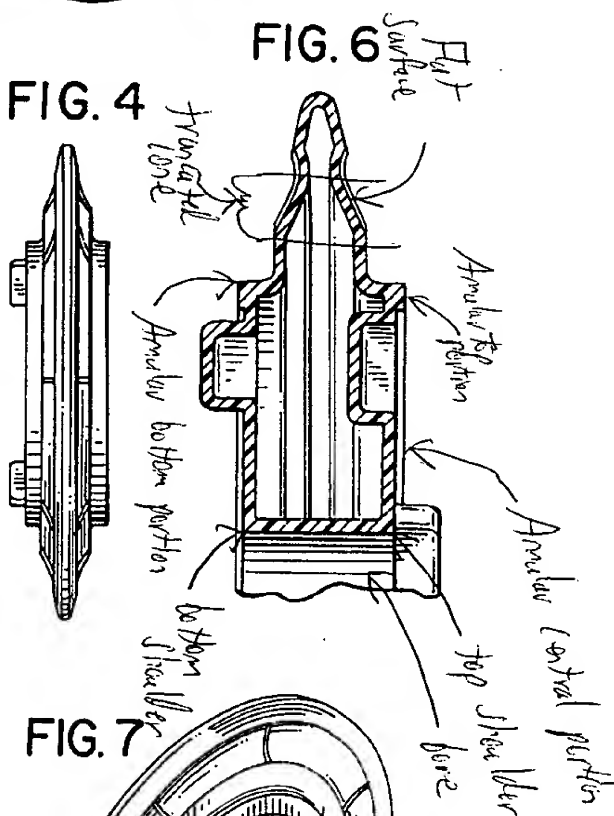


FIG. 5

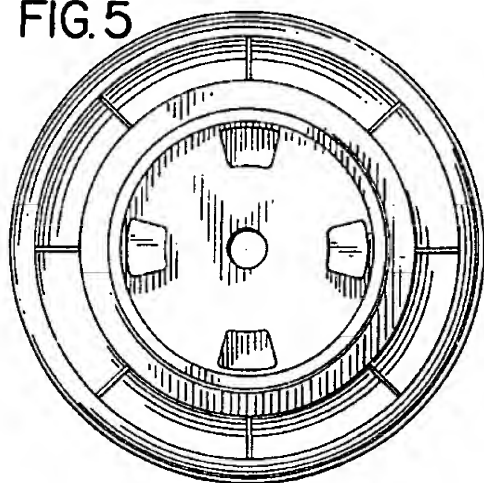


FIG. 7

